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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,310	06/25/2003	Rafael Storz	5005.1051	5265
23280	7590	07/28/2005		
DAVIDSON, DAVIDSON & KAPPEL, LLC 485 SEVENTH AVENUE, 14TH FLOOR NEW YORK, NY 10018			EXAMINER BUI-PHO, PASCAL M	
			ART UNIT	PAPER NUMBER
			2878	

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/603,310

Applicant(s)

STORZ, RAFAEL

Examiner

Pascal M. Bui-Pho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06/25/2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on June 29th, 2002. It is noted, however, that the applicant has not filed a certified copy of the German Application Serial No. 102 29 407.0 application as required by 35 U.S.C. 119(b).

Drawings

2. The drawings are objected to under 37 CFR 1.83(a) because they fail to show sufficient details as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended". If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

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be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 42 and 44 (Fig. 5). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: "It is another object of the present invention to provide a scanning microscope which a allows to set the system..." (Page 4, lines 1-3), "In particularly advantageous fashion, this does not require he user to input the system..." (Page 4, lines 14-17), and "The operating and output

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console 40 includes a keyboard 41, a setting apparatus 41 for the components of the microscope system.” (Page 16, lines 27-28).

Claim Objections

5. Claim 5 is objected to because of the following informalities: the antecedent basis of “the user” on line 3 is unclear. Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-6 and 8-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Foster et al. (US 6,859,273).

With regards to claim 1, Foster et al. teach a method for setting the system parameters of a scanning microscope (10) comprising the steps of controlling an acquisition of an image of a specimen (SP) with a control computer (26), inputting at least one image quality feature after an image of the specimen (SP) is acquired, converting the at least one image quality feature into at least one system parameter of the scanning microscope (10) by the control computer (26), and setting the at least one system parameter (Columns 4-6).

With regards to claim 2, Foster et al. teach a method wherein an image quality feature concerns the contrast or resolution (Columns 2-6). Once an image is obtained and shown, the

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user may perform a variety of operations concerning the contrast or resolution in order to suit individual needs.

With regards to claim 3, Foster et al. teach a method wherein a system parameter of the scanning microscope (10) concerns the power level of a light source (12) (Column 2) or the scanning speed of a scanning unit (Columns 2-6) or the number of individual images to be detected for averaging of an image (Column 6).

With regards to claim 4, Foster et al. teach a method wherein an inputted image quality feature, upon conversion into system parameters of the scanning microscope (10), influences or modifies several system parameters of the scanning microscope (10) (Columns 3-6).

With regards to claim 5, Foster et al. teach a method wherein the system parameters calculated and presently set by the control computer (26) of the scanning microscope (10) are outputted and/or displayed to the user for information (Fig. 3 and columns 3-6).

With regards to claim 6, Foster et al. teach a method wherein the image quality expected to be achievable, for the image quality features presently selected, in the next acquired image is calculated and outputted and/or displayed to the user graphically in color (Column 5-6).

With regards to claim 8, Foster et al. teach a method wherein the number of images of the same specimen (SP) still expected to be detectable is outputted ad/or displayed to the user (Column 6).

With regards to claim 9, Foster et al. teach a method wherein for calculation of the number of images of the same specimen still expected to be detectable, the images hitherto detected are taken into account, with consideration of the system parameter setting applicable in the context of the particular detection (Column 5 and 6).

With regards to claim 10, Foster et al. teach a method wherein each image quality feature is set using a control element (34) provided for it.

With regards to claim 11, Foster et al. teach a method for setting the system parameters of a scanning microscope (10) comprising the steps of controlling an acquisition of an image of a specimen (SP) with a control computer (26), modifying at least one image quality feature after an image of the specimen is acquired, simulating the acquisition of a further image in the context of a modified system parameter, and displaying the simulated further image to the user.

With regards to claim 12, Foster et al. teach a method wherein a simulation encompasses the optical imaging process of the scanning microscope and is based on the image of the specimen already detected (Column 6).

With regards to claim 13, Foster et al. teach a method wherein the user causes a further image acquisition to be performed with the scanning microscope (10) in the context of modified system parameters (Column 6).

With regards to claim 14, Foster et al. teach a method wherein the simulation is accomplished on the control computer (26) of the scanning microscope (10).

With regards to claim 15, Foster et al. teach a scanning microscope (10) comprising a control computer for controlling (26), an operating console (34) for inputting one modified image quality feature after an image of the specimen (SP) is acquired, whereby the at least one image quality feature can be converted by the control computer into at least one system parameter (Columns 4-6) of the scanning microscope that can be set.

With regards to claim 16, Foster et al. teach in their Abstract a scanning microscope that is confocal.

With regards to claim 17, Foster et al. teach a scanning microscope comprising a control computer (26) for controlling an acquisition of an image of a specimen (SP) with the scanning microscope (10) (Columns 3-6), an operating console (34) for inputting at least one modified image quality feature after an image of the specimen is acquired, means for simulating the acquisition of a further image in the context of a modified system parameter (Columns 1-6), and an output console (32) for displaying the simulated further image to the user.

With regards to claim 18, Foster et al. teach in their Abstract a scanning microscope that is confocal.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Foster et al. (US 6,859,273).

With regards to claim 7, the applicant claims a method wherein a color indication is displayed in red, if the selected system parameter setting is contradictory or results in information losses, in yellow, if the calculated system parameter setting generates artifacts, or in green, if the selected system parameter setting appears useful. Foster et al. disclose a method in which samples of emitted fluorescent light can be captured in more than one color channel and the scanning control system (26) can generate color images from this captured data in more than one color channel (Columns 5-6). Although Foster et al. do not designate specific colors for

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sample distinctions, it would have been inherently included, however, if not, it would have been obvious for one of ordinary skill in the art at the time of the invention to modify Foster et al. accordingly in order to provide clearer distinctions between the images.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pascal M. Bui-Pho whose telephone number is (571) 272-2714.

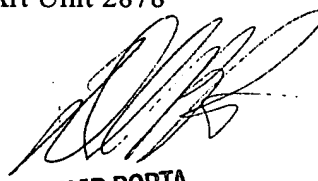
The examiner can normally be reached on Monday through Friday: 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Porta can be reached on (571) 272-2444. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pascal M. Bui-Pho
Examiner
Art Unit 2878

pmb



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